

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

Vinod Chintamani Malshe et al.

Application No.: 10/552,422

Filed: October 7, 2005

Confirmation No.: 6676

For: BIODEGRADABLE ALIPHATIC
POLYESTERS AND
PHARMACEUTICAL COMPOSITIONS
AND APPLICATIONS THEREOF

)

) Art Unit: 1615

)

) Examiner: Caralynne E. Helm

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CERTIFICATE OF TRANSMISSION

)

*I hereby certify that this correspondence is being
submitted via Electronic Filing System or facsimile (571-
273-8300) or USPS to the Commissioner for Patents, P.O.
Box 1450, Alexandria, VA 22313-1450 on:*

)

May 6, 2009

)

Date of Transmission

)

Tamara Daw

)

Name of Person Transmitting Correspondence

)

Signature

Date

MAIL STOP PETITION

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**PETITION UNDER 37 CFR § 1.181 (a) TO WITHDRAW HOLDING OF
ABANDONMENT**

Dear Sir:

On August 26, 2008, the USPTO mailed a Notice of Non-Compliant Amendment to the address of record. However, Applicants never received the Notice of Non-Compliant Amendment. Subsequently, a Notice of Abandonment was mailed on March 17, 2009, citing that Applicants had not timely replied to the Notice mailed on August 26, 2008. Applicants respectfully petition to withdraw a holding of abandonment because, as the following facts show, Applicants never received at the address of record the Notice mailed on August 26, 2008.

1. The instant application was filed on October 7, 2005 with a correspondence address of 1700 N.W. 167th Place, Suite 240, Beaverton, Oregon, 97006 (hereinafter “old address”);
2. On April 7, 2007, the physical and mailing addresses of the Attorneys of Record was changed to 17933 NW Evergreen Parkway, Suite 250, Beaverton, Oregon, 97006 (hereinafter “new address”);
3. On August 26, 2008, the USPTO mailed a Notice of Non-Compliant Amendment to the old address, which was the address of record [Exhibit A: Notice of Non-Compliant Amendment, retrieved from the Public PAIR record of the present application];
4. On September 3, 2008, the USPTO received mail returned undelivered. The undelivered mail comprised the Notice of Non-Compliant Amendment that the USPTO mailed on August 26, 2008 [Exhibit B: Printout of the Notice of Non-Compliant Amendment returned to the USPTO as undeliverable, retrieved from the Public PAIR record of the present application];
5. On March 2, 2009, after the six-month statutory deadline to respond, Examiner Caralynne Helm called the offices of Applicants’ Attorneys of record to determine the status of the present application [Exhibit C: Affidavit of Tamara Daw]; and
6. The March 2, 2009 phone call was the first time that Applicants’ Attorneys were made aware that correspondence, namely the Notice mailed on August 26, 2008, from the USPTO had been mailed and returned to the USPTO as undelivered.

MPEP 711.03(c) I.A. provides:

In Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant’s representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never

received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

Here, as set forth above, the Notice of Non-Compliant Amendment mailed on August 26, 2008 was returned to the USPTO as undelivered, as shown by the record on Public PAIR for the present application. Our office received no further communication from the PTO as to the existence of this Notice of Non-Compliant Amendment until March 2, 2009 (after expiration of the six-month statutory period to respond), when Examiner Helm called our office. Like in *Delgar v. Schulver*, Applicants never received the August 26 Notice of Non-Compliant Amendment in time to respond within the time allotted. Accordingly, Applicants respectfully petition for withdrawal of holding of abandonment of the present application.

Applicants respectfully point out that throughout prosecution of the present application, from its filing date until an amendment filed in June 6, 2008, Applicants have been responsive and diligent in moving the application to allowance. It was only after Applicants did not receive, and were not aware of an Office mailing that Applicants did not timely respond.

Applicants' Attorneys also respectfully point out that Applicants' Attorneys use a sufficiently reliable docketing system for recording Notices, Office Actions, and other USPTO correspondences mailed to the Applicants at the address of record with the USPTO.

Conclusion

In light of the foregoing, petition under 37 CFR § 1.181 (a) to withdraw holding of abandonment is hereby earnestly requested. Any fees or extensions of time believed to be due in connection with this petition are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3130.

Respectfully submitted,
Attorney for Applicant

Dated: May 6, 2009

/Brian D. Wichner/
Brian D. Wichner
Reg. No. 52,359

Customer Number: 43831
Berkeley Law & Technology Group, LLP
17933 NW Evergreen Parkway, Suite 250
Beaverton, OR 97006
503.439.6500



UNITED STATES PATENT AND TRADEMARK OFFICE

EXHIBIT "A"

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,422	10/07/2005	Vinod Chintamani Malshe	044-P001	6676

7590 08/26/2008
Berkeley Law and Technology Group
1700 N. W. 167th Place, Suite 240
Beaverton, OR 97006

EXAMINER

HELM, CARALYNNE E

ART UNIT	PAPER NUMBER
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1615

MAIL DATE	DELIVERY MODE
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08/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES DEPARTMENT OF COMMERCE

U.S. Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10552422	10/7/2005	MALSHE ET AL.	044-P001

Berkeley Law and Technology Group
1700 N. W. 167th Place, Suite 240
Beaverton, OR 97006

EXAMINER

CARALYNNE HELM

ART UNIT

PAPER

1615

20080821

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

The timely submission under 37 CFR 1.129(a) filed on June 6, 2008 is not fully responsive to the prior Office action because applicant has made amendments to the incorrect set of claims. The claims pending in the case are those contained in the amendment submitted to the International Bureau on February 4, 2005 and submitted with the 371 application on October 7, 2005.

Since the submission appears to be a *bona fide* attempt to provide a complete reply to the prior Office action, applicant is given a shortened statutory period of ONE MONTH or THIRTY DAYS from the mailing date of this letter, whichever is longer, to submit a complete reply. This shortened statutory period supersedes the time period set in the prior Office action. This time period may be extended pursuant to 37 CFR 1.136(a). If a notice of appeal and the fee set forth in 37 CFR 1.17(e) were filed prior to or with the payment of the fee set forth in 37 CFR 1.17(r), the payment of the fee set forth in 37 CFR 1.17(r) by applicant is construed as a request to dismiss the appeal and to continue prosecution under 37 CFR 1.129(a). The appeal stands dismissed.

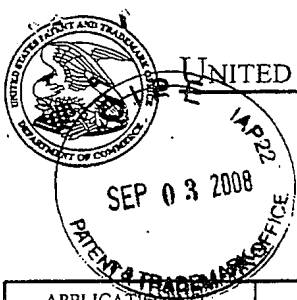
Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARALYNNE HELM whose telephone number is (571)270-3506. The examiner can normally be reached on Monday through Friday 8-5 (EDT).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Caralynne Helm/
Examiner, Art Unit 1615

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615



UNITED STATES PATENT AND TRADEMARK OFFICE

EXHIBIT "B" JFW

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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7590 08/26/2008
Berkeley Law and Technology Group
1700 N. W. 167th Place, Suite 240
Beaverton, OR 97006

EXAMINER

HELM, CARALYNNE E

ART UNIT	PAPER NUMBER
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1615

MAIL DATE	DELIVERY MODE
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08/26/2008

PAPER

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Berkeley Law and Technology Group
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Beaverton, OR 97006

EXAMINER

CARALYNNE HELM

ART UNIT	PAPER
1615	20080821

DATE MAILED:

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Commissioner for Patents

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/Caralynne Helm/
Examiner, Art Unit 1615

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615

Organization **TC1600** Bldg./Room **DEMSEN**
UNITED STATES PATENT AND TRADEMARK OFFICE

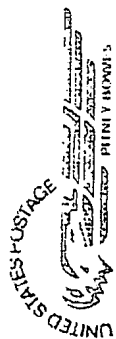
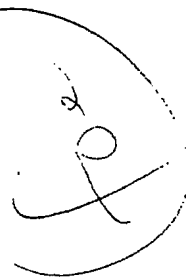
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AFFIDAVIT OF TAMARA RENÉ DAW

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, hereby swears under penalty of perjury under the laws of the United States of America that the foregoing is true and correct:

- 1) My name is Tamara René Daw and I reside at 212 Springwood Dr., Woodland, Washington, 98674, Cowlitz County;
- 2) I am a legal assistant at the Berkeley Law & Technology Group, LLP, a law firm with a principle place of business at 17933 NW Evergreen Parkway, Suite 250, Beaverton, Oregon, 97006;
- 3) On March 2, 2009, Examiner Caralynne Helm telephoned our office and left me a voice mail message requesting to know the status of Application Serial No. 10/552,422. Prior to returning her call on March 2, 2009, I checked our file and saw that we had not received anything from the USPTO. On that same day, March 2, 2009, I went onto PAIR to check the status and discovered that an Office Action had been returned to the USPTO as undeliverable on September 3,

2008. March 2, 2009 was the first time that I was aware of such an Office Action being sent and not successfully delivered to our office.

April 23, 2009
Date

Tamara René Daw
Tamara René Daw

Executed this 23rd day of April, 2009 at Beaverton, Oregon.

Kathryn Laliah Pundt
Signature

State of Oregon)

County of Washington)

Before me personally appeared said Tamara René Daw
and acknowledged the foregoing instrument to be his free act and deed this 28th
_____ day of April, 2009.

Seal:

